

In the United States Patent and Trademark Office

In re the Application of:

Steven Edward Atkin)

Serial Number: 09/891,341)

Group: 2654

Docket Number: AUS920010642US1)

Examiner: Angela A. Armstrong

Filed on: 06/26/2001)

For: "Bi-Directional Domain Names")

REPLY BRIEF

(First Reinstatement)

This is an Appellant's Reply Brief responsive to the Examiner's Answer dated 09/11/2007. For statements regarding the Real Party in Interest, Related Appeals and Interferences, Status of Claims, Status of Amendments after Final Rejections, Summary of the Claimed Subject Matter, Grounds for Rejection For Which Review is Sought, and previously made Arguments, please refer to Appellant's Appeal Brief filed on 05/29/2007.

Response to Examiners' Arguments

Appellant notes that the Examiners have not responded to, or disagreed with the many examples of operation of Abir's process, Feinberg's process, or Applicant's process.

In reviewing of the Examiners' responses to Appellants arguments appearing on pages 8 - 13 of the Examiner's Answer, Applicant believes the rationale for rejection is erroneously based upon piecemeal logic considering individual elements and steps of the claims, but without properly considering the claim as a whole *vis-a-vis* actual start-to-finish results, and overall achieved results of the claimed invention.

Therefore, Appellant is not dissuaded from seeking relief from the rejections, whereas Appellant is due a patent for their invention unless the Examiners have met their burden to establish that the references (a) teach all claimed elements, steps, and limitations, and (b) it would have been obvious to one of ordinary skill in the art at the time of the invention to make the proposed combination and modifications. For these reasons, Appellant maintains all previous arguments.

"Original Label Display Order" Erroneously Equated to "Proper Reading Order"

Examiners have specifically stated and agreed that the proposed combination of Abir and Feinberg would produce the "proper reading order" of the translated text (see Examiners' Answer at pg. 5, lines 14 and 19; pg. 6, lines 2 and 6; pg. 7, lines 10 and 14; and pg. 13 line 18). In fact, the Examiners' proposed motivation to modify and combine the references relies upon the motivation to maintain "proper reading order".

Appellant agrees Feinberg discloses producing text in a word processing context to yield "proper reading order", as this is specifically stated by Feinberg numerous times in Feinberg's disclosure.

However, Appellant claims do not recite "proper reading order", but instead recite "original label display order":

"... said labels having an *original label display order* as encountered from left to right"

wherein the translated URL is a

"... bidirectional domain name in which *said original label display order* is preserved ...".

Appellant respectfully submits that "proper reading order" and "original label display order" are not the same. Original label display order is an order of portions or parts of a URL which are required to be in a certain order according to the protocols used by Internet routers devices to interpret URL's (e.g. Hyper Text Transfer Protocol, etc.). These are machine protocols, and are not spoken or natural language protocols.

"Proper reading order" refers to natural language syntax for spoken languages, and not only specifies a left-to-right or right-to-left order of reading, but also specifies orders of sentences relative to each other.

For example, an untranslated URL in "original label display order" might be:

<http://www.help.databases.ibm.com>

What is the "proper reading order" of such a string of words and delimiters? There are no verbs, subjects, or objects, as exist in natural language, so it is not possible to determine if other orderings would be "proper reading orders" or not.

Would re-ordered "<http://www.databases.ibm.help.com>" be just as understandable to a human? While it is apparent to a human reader that both variations seem to point to a resource to get help for IBM databases, as interpreted by the machine protocol for URLs, these are *absolutely not the same* URL. The first example would be automatically routed to a server *ibm.com*, while the second example would be automatically routed to a server *help.com*.

Consider another set of examples:

<http://www.google.ibm.com>

<http://www.ibm.google.com>

The first URL would be handled by an IBM server at [ibm.com](http://www.ibm.com), but the second URL would be handled by a Google server at [google.com](http://www.google.com). Thus, "original label display order" of a URL which is inherently in a protocol-compliant order is not the same as a natural language "proper reading order".

As such, Appellant respectfully submits that the examples provided in the Appeal Brief illustrate this difference, and that the Examiners have not successfully disputed or proven those examples incorrect.

Further, Appellant respectfully submits that Abir in view of Feinberg fails to teach the claimed aspects of preserving original label display order in the translated URL, but instead teaches preserving "proper reading order" in translated text from word processors, which is not the same as and is not suggestive of how to handle display order of elements of a translated URL.

Appellant believes that the Examiners have erroneously failed to consider this aspect of

the claims, and have failed to indicate where in the references this claim aspect is found. Please note that the recitation of the rationale of the rejections found on page 3 of the Examiner's Answer does not quote these claim aspects, nor is any citation provided where the references are believed to teach them.

Appellant respectfully submits that the Examiners have not established a *prima facie* case of obviousness because the references fail to teach all of the claim steps, elements, and limitations.

Failure to Establish Ordinary Skill in the Art

Since the filing of Appellant's Appeal Brief, the Court has again clarified the requirements of an Examiner in determining obviousness under 35 U.S.C. §103(a) in *KSR International Co. v. Teleflex Inc.* According to the USPTO's Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, Fed. Reg., Vol. 72, No. 195, October 10, 2007, the Examiner is a fact finder required to resolve the "*Graham* inquiries".

According to the Court in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), it is critical to determining obviousness under 35 U.S.C. §103 to ascertain the level of ordinary skill in the art, whereas this is pivotal in the language and standard set forth in the law at §103.

In the rationale for the final rejections, Appellant has not been notified by the Examiner what was determined to be the level of ordinary skill in the art at the time of filing the patent application. It is not clear to Appellant if the Examiner considered any of the criteria for determining the level of ordinary skill in the art under the third factual inquiry of *Graham v. John Deere*, as set forth in *Environmental Designs, Ltd. v. Union Oil*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983) and in *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 449-450, 230 USPQ 416, 420 (Fed. Cir. 1986):

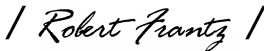
- (1) the educational level of the inventor;
- (2) the type of problems encountered in the art;
- (3) the prior art solutions to those problems;
- (4) the rapidity with which innovations are made by others, not including the inventor;
- (5) the sophistication of the technology; and
- (6) the educational level of active workers in the field not including the inventor.

Appellant respectfully submits that the rejections of all claims under 35 U.S.C. §103(a) are erroneous because they depend on rationale for what an ordinarily skilled artisan would have done at the time of filing where such ordinary skill level has not been properly determined as required by the *Graham* inquiries. Applicant respectfully submits that a holding of obviousness is improper without this factual determination by the Examiner, and requests reversal of the rejections of claims 1 - 15.

Appellant respectfully submits that it would have been an unreasonable leap in logic, reasoning, and concept for an ordinarily skilled person to have modified Feinberg to operate on URL's instead of wordprocessor natural language, especially in view of the fact that Abir and Feinberg fail to teach or suggest critical steps and elements to do so.

For these reasons, Appellant requests reversal of the rejections of claims 1 - 15, and allowance of all claims.

Respectfully,

A handwritten signature in black ink that reads "Robert Frantz". The signature is written in a cursive, flowing style. It is flanked by two large, stylized forward slashes (/) on either side.

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